REMARKS

Claims 1-23 are pending in this application and all stand rejected. Claims 11 and 17 have been amended. Reconsideration and allowance of all pending claims is respectfully requested.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA), in view of Atkinson (U.S. Patent No. 6,498,460) (Atkinson hereinafter). Applicants respectfully traverse the rejections and request reconsideration.

As the PTO recognizes in MPEP §2142:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for at least the following mutually exclusive reasons.

(1) Even when combined, the references do not teach the claimed subject matter.

35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

> In addition, MPEP 2143.03 states "[t]o establish *prima facie* obviousness of a claimed invention, *all the claim limitations must be taught or suggested by the prior art*." Emphasis added and citation omitted.

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach determining if a power adapter or a battery is supplying power to the IHS; continuously monitoring, in real time by hardware components, the output current of the power adapter if the power adapter is supplying power to the IHS; continuously monitoring, in real time by hardware components, the output current of the battery if the battery is supplying power to the IHS; instantaneously reducing the frequency at which the processor operates if the output current of the power adapter exceeds a first threshold current level; and instantaneously reducing the

frequency at which the processor operates if the output current of the battery exceeds a second threshold current level.

Specifically, the Office Action mailed 2/22/2007 states on page 3 that "AAPA *does not disclose* continuously monitoring, in real time by hardware components, *the output current of the power adapter or battery* and instantaneously reducing the frequency at which the processor operates if the power output exceeds a threshold current level." Emphasis added. Thus, the Examiner has conceded that at least the AAPA does not teach or suggest continuously monitoring the *output current of the battery.* The Office Action continues that "Atkinson discloses monitoring, in real time by hardware components [Current Sense in Figure 1], *output current* [it is not specified what output current is monitored] and instantaneously reduces the frequency at which the processor operates [slowing the processor clock frequency] if the output current exceeds a threshold current level [column 5, lines 1-15]." Emphasis Added. It is noted that the rejection does NOT specifically indicate that Atkinson teaches or suggests continuously monitoring the *output current of the battery.* It is submitted that Atkinson DOES NOT teach or suggest continuously monitoring the *output current of the battery* as recited in claim 1.

To the contrary, Atkinson teaches in column 4, the paragraph of lines 21-33 that "[t]he fuel gauge 122 receives as an input the voltage developed across a small value series resistor 120 and this can *monitor the current into the battery. . .* as well as the instantaneous *current into the cells* 118." Emphasis added. See Fig. 1. Other references of current *into* the battery 116 are found in Atkinson in column 7, lines 45-49, however, no references were found in Atkinson regarding monitoring the *output current of the battery.* Therefore, because neither AAPA nor Atkinson teach or suggest all the elements recited in the pending claims, it is impossible to render the subject matter of claim 20 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is defective and should be withdrawn.

Similarly, independent claims 8, 12, 13, 20 and 23 recite, among other things, elements of monitoring an output current of the battery. As explained above, neither AAPA nor Atkinson teach or suggest, among other things, monitoring an output current of the battery. Therefore, the rejections of these claims are also defective and should be withdrawn.

Dependent claims 2-7, 9-10, 14-16 and 21-22 depend from and further limit claims 1, 8, 13 or 20 and are also deemed to be in condition for allowance for at least that reason. See MPEP 2143.03.

(2) The references are not properly combinable as the references do not teach or suggest the combination.

There is still another compelling, and mutually exclusive, reason why the references cannot be applied to reject claims 1-23 under 35 U.S.C. §103(a). The references do not suggest combining or provide a motivation for combining the references to teach the elements as recited in pending claims 1-23.

The PTO provides in MPEP §2142:

> [T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

The PTO additionally provides in MPEP §2143:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). . . The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. 'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art and the *nature of the problem to be solved* as a whole would have suggested to those of ordinary skill in the art.' Emphasis added. Citation omitted.

In light of this, it is submitted that one of ordinary skill would not have combined the references. The AAPA relates generally to information handling system's (IHS's) use of Basic Input Output System (BIOS) software for sensing over-current conditions and reducing processor frequency. On the other hand, Atkinson relates to a system where "[a] power management scheme for a computer system prioritizes battery charging." Atkinson Abstract. Clearly, the nature of the problem to be solved for each of the references is so different as to not lead those of ordinary skill to combine the references. Thus, neither of these references provide any incentive or motivation supporting the desirability of the combination. Therefore, there is

simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1-23.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

The courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination and any rejection MUST point to the teaching, suggestion or motivation to combine the references. See e.g. *In re Kahn*. In the present case the Examiner has not pointed to any teaching, suggestion or motivation to combine the references. Thus, it is clear that the examiner's combination arises solely from hindsight based on the invention. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1-23, and the rejection under 35 U.S.C. §103(a) is not applicable.

In addition to the foregoing, Independent claims 11 and 17 have been amended to recite, among other things, "instantaneously reducing the frequency at which the processor operates . . . by receiving a processor hot signal at the processor." Once again, there is no motivation to combine the references to teach or suggest the elements as claimed in amended claims 11 and 17. Therefore any rejection using the combination of the references is defective and fails. Dependent claims 18 and 19 depend from independent claim 17 and are allowable as depending from an allowable independent claim.

In view of the above, the allowance of claims 1-23 is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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